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10/685,626	10/14/2003	Larry G. Kent JR.	030137; 190250-1150	5085
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/685,626

**Applicant(s)**

KENT ET AL.

**Examiner**

J Bret Dennison

**Art Unit**

2443

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-12, 20-27, 38 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-12, 20-27, 38 and 44-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Action is in response to the Amendment for Application Number 10/685,626 received on 8/18/2008.
2. Claims 5-12, 20-27, 38 and 44-46 are presented for examination.

#### ***Response to Amendment***

3. Applicant's arguments and amendments filed on 8/18/2008 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's substantial amendment to the claims which significantly affected the scope thereof (i.e., by incorporating new limitations into the independent claims, which required further search and consideration).
4. Applicant's amendment to claim 20 does nothing to remove the non-statutory embodiments, as a computer readable medium is still defined as (one example) a propagation medium in Applicant's specification (see corresponding US publication 2005/0080866). As such, the claim is still directed towards non-statutory subject matter and the rejection is maintained.
5. It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.
6. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims

with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

***Claim Objections***

Claim 44 is objected to because of the following informalities: Claim 44 depends from a canceled claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 20-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
8. Claim 20 has been amended to recite a "computer-readable medium that stores a program."
9. Applicant's specification states (see corresponding US publication 2005/0080866):

"In the context of this document, a "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer-readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium. More specific examples (a nonexhaustive list) of the computer-readable medium would include the following: an electrical connection (electronic) having one or more wires, a portable computer diskette (magnetic), a random access memory (RAM) (electronic), a read-only memory (ROM) (electronic), an erasable programmable read-only memory (EPROM or Flash memory) (electronic), an optical fiber (optical), and a portable compact disc read-only memory (CDROM) (optical). Note that the computer-readable medium could even be paper or another suitable medium upon which the program is printed, as the program can be electronically captured, via for instance optical scanning of the paper or other medium,

then compiled, interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory.”

10. Therefore, Applicant has provided intrinsic evidence in the specification that the phrase “computer-readable medium” as used in the claims is intended to cover multiple types of non-statutory subject matter.

11. As one example, Applicant’s inclusion of a “propagation medium” would have been reasonably interpreted by one of ordinary skill as a form of energy rather than a process, machine, manufacture or composition of matter.

12. Therefore, claims 20-27 are not limited to embodiments which would enable the program to act as a computer component and realize its functionality to provide a practical application with a useful, concrete and tangible result.

13. As such, claims 20-27 are not limited to statutory subject matter and is therefore non-statutory.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 44-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant’s Specification does not provide the

written description for displaying the termination time in the status bar area. There is nothing in Applicant's specification that even corresponds the termination time with the status bar area. The only recitation of a termination time exists in paragraph [0041] of the corresponding PGPU, And this only corresponds to the IM chat log.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5-11, 20-26, 38, and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klassen et al. (US 2005/0066070) in view of Malik (US 7007085) and further in view of Roskind (US 2003/0065721).

16. Regarding claim 5, Klassen disclosed a communication method comprising:

displaying a first instant messaging (IM) message (Klassen, Fig. 4, message 74 [0042]);

calculating an elapsed time from the displaying of the first IM message (Klassen, [0045], "predetermined duration of time");

determining whether a second IM message has been displayed within the elapsed time (Klassen, [0045]);

displaying a first time indication, the first time indication being associated with the first IM message, the first time indication being displayed in response to determining that the second IM message has not been displayed within the elapsed time, the first time indication displaying a time that the first message was sent (Klassen, Fig. 4, [0045] "a first time stamp 84 is output adjacent the non-responded message").

Klassen further disclosed the ability to provide a timestamp for the most recently transmitted message in order to save space on the display of the device (Klassen, [0057]).

While Klassen disclosed the use of instant messaging, Klassen did not explicitly state querying the user about whether to add certain information within an IM log.

In an analogous art, Malik disclosed a message log for instant messaging in which the system gives options to the user in the form of preferences, which includes a preference for additional information (Malik, col. 9, lines 35-45). As shown in Figure 4, the teachings of Malik present the user with defined options to choose from (i.e. querying the users as to their preferences). Malik further disclosed one of the preferences to include the time of the communication (Malik, col. 11, lines 25-35).

One of ordinary skill in the art would have been motivated to combine the teachings of Klassen and Malik since both provide features of instant messaging, and as such, combining the teachings would not involve any extra implementation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the IM log feature of Malik into the teachings of Klassen in order to obtain the predictable result of providing users with the ability to

review past conversations according to their preferences, providing users more instant messaging features thereby increasing desirability of use by customers over competing products.

However, while the combined teachings of Klassen and Malik disclosed querying the user for preferences regarding the log including the time of communication (Malik, col. 11, lines 25-35), Klassen and Malik did not explicitly state the details of what the "time of communication" actually includes. As such, the combination of Klassen and Malik did not explicitly state a termination time indication that indicates a time an IM session terminated.

In a related art, Roskind disclosed a system of instant messaging that provides an IM log that includes IM activity which may provide the existence or status of separate IM sessions as well as the opening and closing of an IM session (Roskind, [0095]). Roskind further disclosed that "updating the IM log also may include tracking the time that each instant message was sent and received, recording the time the IM session was closed, and/or recording the time the sender or recipient disconnected from the host (Roskind, [0097]). Since Roskind disclosed that updating the log also "may" include such a session termination time, it would have been obvious to one of ordinary skill that such may simply be a feature of IM logging.

One of ordinary skill in the art would have been motivated to combine the teachings of Klassen and Malik and Roskind since all three teachings are within the same instant messaging environment.



Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the option of logging the termination time as disclosed by Roskind within the combined teachings of Klassen and Malik in order to obtain the predictable result of providing extra options to users, thereby allowing them to set up their instant messaging logs into a more desired format, in order to make readability of the log easier for the user according to their preferences, thereby further increasing desirability of use by its customers over competing products.

While the combination of Klassen, Malik, and Roskind disclosed the limitations as described above, Klassen, Malik, and Roskind did not explicitly state wherein the display of the timestamp for the most recently transmitted message is in a status bar area that is distinct from the IM dialog box.

Applicant's specification does not provide any specific benefit for providing this time stamp within a status bar that is distinct from the text area, so it is assumed that such has to do with the main reason behind the invention, which is to save display space or reduce clutter (Applicant's Specification, [0006]). Since it has been shown above that the teachings of Klassen disclosed that the display of the most recent time stamp is performed in order to save display space, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place this timestamp in any area of the instant message as such a placement still requires the room to display this timestamp, and therefore, wherever the timestamp is placed, the same amount of display space is saved. In other words, whether the timestamp is placed in a status bar or not, it still requires taking up space on the display device. Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the combined teachings of Klassen, Malik, and Roskind the placement of the timestamp of the most recently received message into a status area that is distinct from the text area, thereby allowing the programmer to design the display of the instant message in any way desired, and in order to obtain the predictable result of reducing clutter on the display screen.

Claim 20 includes a computer-readable storage medium comprising a processor and a memory configured to store computer-readable code to implement the limitations of claim 5. Claim 38 includes a communication system comprising logic to implement the limitations as described in claim 1. The combined teachings of Klassen, Malik, and Roskind disclosed a device storing code/logic to perform the limitations as claimed (for example, See Klassen, Figs. 1 and 2). As such, claims 20 and 38 are rejected under the same rationale as claim 5.

17. Regarding claims 6 and 21, Klassen, Malik, and Roskind disclosed the limitations as described in claims 5 and 20, including wherein the step of displaying the first IM message comprises: providing an IM dialogue box within an IM chat window; and displaying the first IM message within the IM dialogue box (Klassen, Fig. 4). See motivation above.

18. Regarding claims 7 and 22, Klassen, Malik, and Roskind disclosed the limitations as described in claims 6 and 21, including wherein displaying the first time indication

comprises: displaying the first time indication in the IM dialogue box (Klassen, Fig. 4, time stamp 84). See motivation above.

19. Regarding claims 8 and 23, Klassen, Malik, and Roskind disclosed the limitations as described in claims 5 and 20, including wherein displaying the first time indication comprises: displaying a first visual delineator after the first IM message, the first visual delineator having a time associated with the first IM message (Klassen, Fig. 4, time stamp 84). See motivation above.

20. Regarding claims 9 and 24, Klassen, Malik, and Roskind disclosed the limitations as described in claims 5 and 20, including displaying a second IM message after the elapsed time; displaying a second time indication, the second time indication being associated with the second IM message, the second time indication being indicative of the elapsed time between the first IM message and the second IM message (Klassen, Fig. 4, 47, "second time stamp 92 is output adjacent the resumption message. A user thus can determine from the output on the display 50 the period of time during which the conversation was suspended"). See motivation above.

21. Regarding claims 10 and 25, Klassen, Malik, and Roskind disclosed the limitations as described in claims 9 and 24, including wherein displaying the second time indication comprises: displaying a second visual delineator before the second IM

message, the second visual delineator having a time associated with the second IM message (Klassen, [0045], last the lines, see also Fig. 8b). See motivation above.

22. Regarding claims 11 and 26, Klassen, Malik, and Roskind disclosed the limitations as described in claims 10 and 25, including wherein displaying the second visual delineator comprises: providing an IM dialogue box within an IM chat window; and displaying the second visual delineator in the IM dialogue box (Klassen, Fig. 8b, 292). See motivation above.

23. Regarding claims 44-46, Klassen, Malik, and Roskind disclosed the limitations as described in claims 5, 20, and 38, but did not explicitly state wherein the termination time is displayed in the status bar area. However it would have been obvious to one of ordinary skill in the art at the time the invention was made to display the termination time within the status bar area as such an area is a useful place to provide information regarding the instant message, and the placement of the termination time within this area would reduce the chances of the user confusing this time with the time that one of the messages was sent.

24. Claims 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klassen et al. (US 2005/0066070) in view of Malik (US 7007085) and Roskind (US 2003/0065721) and further in view of Applicant's Admitted Prior Art ("AAPA"), specifically in view of the prior art instant messaging systems presented in the Background section of Applicant's Specification.

The Applicant described instant messaging systems with reference to Figures 1 and 2, which are provided as prior art figures. Therefore, the description provided in the background section in reference to these Figures are construed by the Examiner to constitute an admission of prior art and any subject matter associated with these descriptions are construed to be prior art applicable to the claims. See MPEP 2129 and *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003).

25. Regarding claims 12 and 27, Klassen, Malik, and Roskind disclosed the limitations as described in claims 11 and 26, including selectively displaying a most-recently-displayed IM time in the IM dialogue box, the most-recently-displayed IM time being associated with the most-recently-displayed IM message (Fig. 4, 84).

Klassen, Malik, and Roskind did not explicitly state providing a status area within the IM chat window, the status area being distinct from the IM dialogue box.

However, AAPA shows areas above and below item 205 (see AAPA, Fig. 2) within the IM chat window that are distinct from the IM dialogue box. As such, AAPA shows that it was well known in the art at the time the invention was made that instant messaging chat windows include status windows.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a status window in the instant messaging chat boxes of the combined teachings of Klassen, Malik, and Roskind in order to provide users with the status of a message before sending the message to its recipient, or

provide extra information regarding the message, thereby providing extra features to the instant messaging system, making the system more desirable to use by its customers.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J Bret Dennison/  
Primary Examiner, Art Unit 2443